

Notice of Allowability

Application No.

10/054,611

Applicant(s)

CECH ET AL.

Examiner

Art Unit

Malgorzata A. Walicka

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 05/26/05.
2. ☒ The allowed claim(s) is/are 1-9,13-16,35,37,39-41,43,45-64 and 66.
3. ☒ The drawings filed on 26 July 2004 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

The Amendment and Response to Office Action filed May 26, 2005 is acknowledged. Claims 1, 2, 13, 14 and 23 have been amended. Claims 10-12, 17-22, 24-25 and 26-34, 36, 38, 42 and 44 have been canceled. New claims 47-66 have been added. Claims 1-9, 13-16, 23, 35, 37, 39, 41, 43, 45- 66 are pending. Claims 1-9, 13-16, 35, 37, 39, 41, 43 45-46 and new claims 47-64 and 66 read on the elected invention. Claims 23 and new claim 65 are directed to the nonelected product, and are withdrawn from examiner's consideration for the reasons indicated in the Office Action of December 8, 2004.

DETAILED ACTION

1. Objections

1.1. Priority

Examiner's objections to priority of the claims to US Application No. 08/844,419 (filed April 18, 1997) and 08/846,017 (filed April 25 1997) is withdrawn because the claims have been amended and currently comprise a set of claims directed to the method having priority to US Application No. 08/844,419 (filed April 18, 1997) and 08/846,017 (filed April 25 1997).

2. Rejections

2.1. 35 USC, section 112, second paragraph

Rejection of claims 10-12, and 17-22 made in the Office Action of December 8, 2004 (previous Office Action) is moot, because the claims have been canceled.

Art Unit: 1652

Rejection of claims 2-9 and 40 for the phrase "hybridizes specifically" is withdrawn, because claim 2 has been amended and Applicants' arguments are found persuasive.

Rejection of claims 2-9 and 14-16 claim for use of the indefinite phrase **primer that consists essentially of** is withdrawn because the clear definition of the term "consisting essentially of" has been provided by Applicants in their Remarks of May 26, 2005.

2.2. 35 USC, section 112, first paragraph

2.2.1. Scope of enablement

Rejection of claims 10-12 and 17-21 made in the previous Office Action is moot, because the claims have been canceled.

Rejection of claims 2-9, 14-16 and 40 under 35 U.S.C. 112, first paragraph, made in the previous Office Action is now withdrawn, because a clear definition of the term "consisting essentially of" has been provided by Applicants in their Remarks of May 26, 2005. The claims are now enabled.

2.3. 35 USC section 103

Claims 1-9, 12-19, 21 and 22-37, 39-43 and 45-46 were rejected in the previous Office Action under 35 U.S.C. 103(a) as being unpatentable over Strausberg's human sequence AA281296 entered to NCB1 data base in April 2, 1997, in view of Linger et al.

Art Unit: 1652

(Reverse Transcriptase Motifs in the Catalytic Subunit of Telomerase, Science, published April 25, 1997, 276/5312, pages 561-567).

Rejection of claims 12, 17-19, 21-22, 24-34, 36 and 42 is moot because the claims have been canceled.

Rejection of claims 1-9, 13-16, 35, 37, 39-41, 43 and 45-46 is withdrawn, because the claims, after amendment, are limited to the methods of using probes and primers that do not hybridize to SEQ ID NO:62. Thus, thus the probes of the claims are not anticipated by prior art.

Rejection under 103(a) of newly filed claims 47-64 and 66 over Strausberg's human sequence AA281296 entered to NBCI data base in April 2, 1997 in view of Linger et al. (Reverse Transcriptase Motifs in the Catalytic Subunit of Telomerase, Science, published April 25 1997, 276/5312, pages 561-567) would be improper because the claims have valid priority to Application No. 08/844,419 (filed April 18, 1997) and 08/846,017 (filed April 25 1997). Thus, the article by Linger et al. does not provide motivation to make the claimed invention.

Claims 1-9, 22 and 35-46 were also rejected in the previous Office Action as being unpatentable over Adams et al. homo sapiens cDNA sequence AA311750 (Initial assessment of human gene diversity and expression patterns based on 83 million nucleotides of cDNA sequence, Nature 377 (6547 Suppl), 3-174, 1995) in view of the paper by Linger et al. (Reverse Transcriptase Motifs in the Catalytic Subunit of Telomerase, Science, published April 25 1997, 276/5312, pages 561-567).

Art Unit: 1652

Rejection of claims 22, 36, 38, 42 and 44 is now moot because the claims have been canceled.

Rejection of claims 1-9, 35, 37, 39-41, 43 and 45-46 is withdrawn, because it was improper for the following reasons. Adams and al. teach *Homo sapiens* cDNA 5' sequence identified as locus AA311750. This EST sequence is 258 nucleotides long, and exhibits 97.7% homology with the fragment of SEQ ID NO: 224 which consists of nucleotides 2649-2906. AA311750 comprises 164 nucleotide long, 20 nucleotide long, and 64 nucleotide long consecutive fragments of SEQ ID NO: 224. Although SEQ ID NO: 224 consists of fragments that are identical to fragments of Adams' sequence, Linger et al. could not teach the use of probes from AA311750. There is nothing specific in the region of nucleotides 2649-2906 of SEQ ID NO:224 that has been known by Linger et al. Thus, Linger et al. could not provide motivation for using Adams et al.'s sequences as probes.

4. Examiner's amendment

Please cancel claims 23 and 65.

Authorization for this examiner's amendment was given in a telephone interview with Michael Schiff on June 6, 2005.

5. Conclusion

Claims 1-9, 12-16, 35, 37, 39, 40-41, 43, 45-64 and 66 are allowed for the reasons explained in the previous Office Action.

Art Unit: 1652


Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached on (571) 272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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